

**IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF OHIO
EASTERN DIVISION**

WAGO VERWALTUNGSGESELLSCHAFT MBH,
Plaintiff,

v.

ROCKWELL AUTOMATION, INC.,
Defendant.

Case No. 1:11CV756

JUDGE CHRISTOPHER A. BOYKO

**REVISED REPORT OF PARTIES' PLANNING MEETING
UNDER FED. R. CIV. P. 26(f), L.R. 16.3(b)(3) AND L.P.R. 2.1**

On June 10, 2011, Plaintiff WAGO Verwaltungsgesellschaft mbH and Defendant Rockwell Automation, Inc. filed a joint REPORT OF PARTIES' PLANNING MEETING UNDER FED. R. CIV. P. 26(f), L.R. 16.3(b)(3) AND L.P.R. 2.1 (Dkt. 42). The parties jointly submit the following revised planning report in the form set forth in Appendix B of the Local Patent Rules.

Plaintiff WAGO Verwaltungsgesellschaft mbH and Defendant Rockwell Automation, Inc. submit the following revised joint discovery plan:

1. Parties' Discovery Conference. Pursuant to Fed. R. Civ. P. 26(f) and L.R. 16.3(b), a telephonic meeting, held on June 3, 2011, was attended by:

Mark C. Johnson, counsel for plaintiff WAGO Verwaltungsgesellschaft mbH

Paul J. Tanck, counsel for defendant Rockwell Automation, Inc.

In addition, a telephonic meeting regarding modifications to the parties' initial proposed schedule was held on June 29, 2012 and attended by:

Mark C. Johnson, counsel for plaintiff WAGO Verwaltungsgesellschaft mbH

Paul J. Tanck, counsel for defendant Rockwell Automation, Inc.

2. The parties do not consent to the jurisdiction of the United States Magistrate Judge pursuant to 28 U.S.C. § 636(c).

3. **Scheduling**

The parties exchanged the disclosures required by L.P.R. 3.1, 3.2, 3.3 and 3.4 prior to the June 17, 2011 case management conference.

Defendant's Position on Scheduling

Defendant has raised the issue with Plaintiff that Plaintiff's exclusive licensee under the asserted patent, Wago Kontakttechnik ("WKT"), needs to be joined as a necessary party in this lawsuit. WKT is a German company that is related to Plaintiff. On information and belief, WKT is responsible for designing and developing the products that embody the patented technology and has the exclusive right to make, use, and sell products under the asserted patent. Plaintiff has not consented to joining WKT as a necessary party. Since, Plaintiff will not consent to joining WKT, Defendant is preparing a motion under FRCP 12(b)(7) and Rule 19 to dismiss the action based on the failure to join an indispensable party.

If WKT is not joined in this lawsuit (and the lawsuit proceeds), third party discovery from WKT will still be necessary and critical to proving the parties' claims and defenses in this lawsuit. Plaintiff will not agree, however, to produce WKT's documents that are responsive to Defendant's discovery requests. Absent Plaintiff's cooperation, discovery will likely proceed pursuant to the Hague Convention, which is an impediment to expeditious discovery. See Hegenbuch v. 3B6 Sistemi Elettronici, 2005 WL 6246195, *5 (N.D. Ill. Sept. 12, 2005) ("[C]ompliance with the Hague Convention may be difficult and time consuming" and "[t]he party seeking discovery may find it difficult to determine what evidence is in the control of the party urging resort to the Convention."); see also U.S. State Dept. Circular

(http://travel.state.gov/law/judicial/judicial_648.html). Accordingly, Defendant's proposed schedule reflects the additional time required to take evidence abroad in Germany, which in some instances may take 6-12 additional months to obtain.

Plaintiff's Position on Scheduling

Plaintiff's proposed schedule is consistent with the LPR, where the dates are calculated from the service of Rockwell's Rule 3.5 contentions. The Court's order denying Rockwell's Rule 12(c) motion issued on March 7, 2012. LPR 3.5 invalidity contentions are due no later than 80 days from the filing of an answer. Rockwell should not be permitted to further delay service of its Rule 3.5 contentions.

WKT is a German company, but it is not "related to" WVG. Discovery from WKT is not necessary, and certainly not critical, for any of Rockwell's claims or defenses. WVG does not control WKT, nor is WVG controlled by WKT. WVG and WKT have different shareholders and are independently controlled under German law.

Moreover, WKT does not own the patent-in-suit, nor does WKT have any right to enforce the patent-in-suit. WVG has the *sole* right to enforce the patent-in-suit at its *sole* discretion. WKT is one of multiple parties licensed under the patent-in-suit. This Court does not have jurisdiction over WKT. WKT is not an indispensable party.

Notwithstanding these facts, WKT has agreed to provide document production to the extent such production does not invade the individual rights of its employees or require WKT to perform acts in contravention of German law, including German privacy laws and German employment laws, including but not limited to the German Federal Data Protection Act. Moreover, WKT has already provided substantial production relating to the manufacture and

design of products WVG contends are covered by the patent-in-suit, and relating to licenses to third parties under the patent-in-suit.

The parties propose the following schedule:

Event	Plaintiff's Proposal	Defendant's Proposal
Rule 26(a)(1) Initial Disclosures	Fri. 08/10/2012	Fri. 08/10/2012
L.P.R. 3.5 Invalidity and Unenforceability Contentions	Thu. 08/16/2012	Thu. 12/09/2012
Deadline for amending pleadings and adding parties	Fri. 08/29/2012	Wed. 4/19/2012
L.P.R. 4.1(a) and (b) Exchange of Proposed Terms for Construction and Supporting Materials	Fri. 08/31/2012	4/03/2012
L.P.R. 3.7 Plaintiff's Responses to Defendant's Invalidity and Unenforceability Contentions	Wed. 09/05/2012	4/11/2012
L.P.R. 4.1(c) Final List of Claim Terms	Thu. 09/20/2012	4/19/2012
L.P.R. 4.2(a) Exchange of Preliminary Claim Constructions and Evidence	Fri. 10/05/2012	5/02/2012
L.P.R. 4.3(a) Disclosure of Claim Construction Expert	Mon. 10/15/2012	5/16/2012
L.P.R. 4.3(b) Disclosure of Rebuttal Claim Construction Expert	Tues. 11/06/2012	6/03/2012
L.P.R. 4.3(c) Completion of Expert Claim Construction Discovery	Wed. 11/21/2012	6/18/2012
L.P.R. 4.2(c) Exchange of Final Claim Constructions	Mon. 11/26/2012	6/24/2012
L.P.R. 4.4(a) Claim Construction Submissions	Thu. 11/29/2012	07/08/2013
L.P.R. 4.4(b) Responsive Claim Construction Submissions	Mon. 01/07/2012	08/07/2013
L.P.R. 4.5 Joint Claim Construction and Prehearing Statement	Mon. 01/14/2013	Thurs. 08/14/2013

The schedule above tracks the proposed schedule set forth in the Local Patent Rules. The parties propose that a Joint Status Report shall be filed within 15 days of the date of the Court's claim construction ruling and that such report should recommend deadlines for LPR 4.7, 4.8 and a dispositive motion briefing schedule (LPR 6.1). The Joint Status Report will provide an update

on third party discovery pursuant to the Hague Convention and any potential deadlines that need to set or adjusted as a result.

4. Anticipated Motions

- a. The parties anticipate filing the following motions:
 - i. ___ Preliminary injunction. Proposed briefing schedule: N/A
 - ii. ___ Motion to add or substitute parties. Proposed briefing schedule: N/A
 - iii. ___ [Other]. Proposed briefing schedule:
- b. The following issues may be the proper subject of an early motion for summary judgment or partial summary adjudication:
 - i. ___ Inventorship or Indefiniteness (describe basis)
 - ii. ___ Invalidating sale, offer for sale, or display (describe basis)
 - iii. x Other (describe basis) Defendant's Motion to Dismiss For Failure To Join an Indispensible Party Under Rule 12(b)(7) and Rule 19 of the Federal Rules of Civil Procedure

5. Nature of Dispute

- a. Describe the field of the claimed invention: The claimed invention relates to input/output devices for a data bus, such as for use to provide power for machines and installations, etc. Specifically, the modules are adapted for use with support rails and are configured such that as adjacent modules are added, a connection is formed between data bus and power supply line terminals on adjacent modules so that data bus and power supply line paths are extended. The modularity of the system permits customized connections to different type of machines, processor systems, etc. to the same data bus and power supply lines.

- b. Claims asserted: 1-4.
- c. The parties anticipate requesting that the Court construe 10-15 claim terms.
- d. Describe the allegedly infringing activity or product: The accused products are a combination of Rockwell's removable terminal base (wiring) units and Rockwell's input/output modules. Plaintiffs allege that the combination of the base units with modules forms modular input/output devices that are adapted for use with support rails and are configured such that as adjacent modules are added, a connection is formed between data bus and power supply line terminals on adjacent modules so that data bus and power supply line paths are extended. Rockwell offers different input/output modules that permit customization.
- e. Describe any potentially non-infringing alternative designs: Discovery has only just begun and it is too early to know the basis for any non-infringing alternative designs. Defendants do not believe that the accused products infringe and therefore those products themselves are "non-infringing alternative designs."
- f. The parties have not stipulated that the above-described designs do not infringe the patents in issue.

6. **Discovery**

- a. The parties do not anticipate needing to propound interrogatories and/or take depositions in excess of the number provided in the Federal Rules of Civil Procedure.
- b. Counsel for the parties are still in the process of determining the extent to which special procedures, if any, will be required for the discovery of electronically

stored information. Defendant suggests that the parties use the Federal Circuit's Model Order on E-Discovery paragraphs 6-11 to govern the production of emails. http://www.cafc.uscourts.gov/images/stories/announcements/Ediscovery_Model_Order.pdf. Plaintiff maintains that the parties should comply with the Federal Rules of Civil Procedure and the LPR to develop an E-Discovery plan consistent with Appendix K. There is no reason to depart from the recently amended Federal Rules and local rules, which have been put in place to handle such matters.

The parties agree that ESI shall be produced electronically in an imaged, searchable form.

In addition, the parties agree that when using an outside vendor to produce documents, production to WVG shall include a Summation load file (i.e., a .dii file), and production to Rockwell shall include a concordance load file.

- c. For party witnesses testifying in a language other than English, only one-half (.5) the length of the examination shall count toward the time limit imposed by the Rules, providing that should the witness be deposed for more than 7 hours on the record, it be split over two days; for example, a party is permitted to conduct 14 hours of examination over two days of a deponent testifying in a foreign language.
- c. The parties anticipate the following discovery issues: See the parties' positions on scheduling above.

7. **Protective Order**

- a-b. The parties are submitting an alternative proposed stipulated protective order for adoption by the Court.
- c. Identify any issues the Court should be aware of with respect to the confidentiality concerns of the parties: the parties do not anticipate any confidentiality concerns.

8. **Claim Construction Hearing.** The parties propose the following format for the Claim Construction Hearing:

- a. Order of presentation: Plaintiff then Defendant
- b. Anticipated number of witnesses: The parties' LPR 4.5 Joint Claim Construction and Prehearing Statement will set forth the parties' positions as to the number and identities of any anticipated witnesses.
- c. Anticipated length of hearing: 3-4 hours

9. **Electronic Exchange of Documents.** The parties have consented, pursuant to Fed. R. Civ. P. 5(b)(2)(E), to the electronic exchange of pleadings, notices, discovery, and other mandated disclosures not otherwise served electronically via the Court's electronic filing system. In addition, the parties have agreed that when service is made pursuant to Fed. R. Civ. P. 5(b)(2)(E), an additional three days shall not be added to a period that would otherwise expire under Fed. R. Civ. P. 6(a).

10. **Alternative Dispute Resolution.** The parties have discussed settlement and the appropriateness of Alternative Dispute Resolution. The parties have determined that the case is not suitable for Alternative Dispute Resolution at this time, but may be so at some point during discovery or after the completion of discovery.

11. **Miscellaneous**

The parties have agreed that no party shall be required to identify on its withheld document log any document or communication dated on or after the filing date of this action (*i.e.*, February 17, 2011) which, absent this provision, the party would have been obligated to identify on its withheld document log.

Date: August 3, 2012

Respectfully submitted,

/s/ Paul J. Tanck (by consent)

Scott Balber (admitted in N.D. Ohio)
Paul J. Tanck (admitted *pro hac vice*)
Chadbourne & Parke LLP
30 Rockefeller Plaza
New York, N.Y. 10112
(212) 408-5100 (voice)
(212) 230-8888 (fax)
sbalber@chadbourne.com
ptanck@chadbourne.com

COUNSEL FOR DEFENDANT
ROCKWELL AUTOMATION, INC.

/s/ Mark C. Johnson

Jay R. Campbell
Mark C. Johnson
Renner, Otto, Boisselle & Sklar, LLP
1621 Euclid Avenue, 19th Floor
Cleveland, Ohio 44115
(216) 736-3170 (voice)
(216) 621-6165 (fax)
jcampbell@rennerotto.com
mjohnson@rennerotto.com

Robert N. Cook
Whitham, Curtis, Christofferson & Cook, P.C.
11491 Sunset Hills Road, Suite 340
Reston, Virginia 20190
(703) 787-9400 (voice)
(703) 787-7557 (fax)
bob@wcc-ip.com

COUNSEL FOR PLAINTIFF
WAGO VERWALTUNGSGESELLSCHAFT
MBH

CERTIFICATE OF SERVICE

I certify that, on August 3, 2012, I caused the foregoing REVISED REPORT OF PARTIES' PLANNING MEETING UNDER FED. R. CIV. P.26(f), L.R. 16.3(b)(3) AND L.P.R. 2.1 to be electronically filed. All parties are represented by attorneys of record registered with CM/ECF and will receive service electronically. There is no party requiring a different form of service.

/s/ Mark C. Johnson

Mark C. Johnson

Counsel for Plaintiff

WAGO VERWALTUNGSGESELLSCHAFT
MBH